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146.1309

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: : L.E. Smith
JEAN-LUC DUBOIS :
Serial No.: 194,996 :
Filed: December 4, 1998 :
For: TRANSDERMIC...MEDICAMENTS :

600 Third Avenue
New York N.Y. 10016
August 3, 2000

RECEIVED

RENEWED PETITION UNDER 37 CFR 1.47(b)

03 AUG 2000

Asst. Commissioner for Patents
Washington, D.C. 20231

Legal Staff
International Division

Sir:

Responsive to the decision on the renewed petition in the above application dated July 26, 2000, Applicant renews the request for the granting of the petition to accept the application and reconsideration is requested under the provisions of Rule 1.47(b).

The decision on the renewed petition indicated that the requirements 1, 2 and 6 of Rule 147(b) have been complied with. However, the Legal Examiner indicated that requirements 3, 4 and 5 have not been complied with.

With respect to item 5, the Legal Examiner indicated that the record did not clearly support the proposition that Hoechst Marion Roussel had sufficient proprietary interest in the application to execute the same in the absence of the inventor's refusal to execute the application. The Legal Examiner indicated that Mr. Vieillefosse states in Exhibit B that Mr. Dubois is required to assign all inventions to Hoechst Marion Roussel was not supported


by the record. The Legal Examiner indicated that the translation of Exhibit B suggested that there are limitations on inventions which must be assigned. With respect to item 4, it was not clear to the Legal Examiner that Mr. Dubois' latest address had been provided. With respect to item 3, the Legal Examiner objected to the fact that Mr. Vieillefosse failed to set forth the last known address of Mr. Dubois and clarification of the last known address was required.

It is believed that the Legal Examiner has completely misinterpreted the present record. With respect to the requirement that Mr. Dubois was required to assign all inventions to Hoechst Marion Roussel, the Legal Examiner's attention is directed to Exhibit C and the English translation thereof attached to the declaration of August 31, 1999 of Mr. Vieillefosse. On page 2 of the English translation, lines 14 and 15 thereof state unequivocally "Your studies, research and results are the full and total property of our company." This unequivocally substantiates the fact that by a contract, Mr. Dubois was required to assign his inventions to Hoechst Marion Roussel. With respect to Exhibit B and the English translation thereof, the Legal Examiner did not indicate where there is any ambiguity or limitations on the inventions which must be assigned. The French contract between the inventor and the company is unequivocal on this point. Therefore, Applicant has clearly complied with item 5.

With respect to the most recent address of the inventor, the Legal Examiner's attention is directed to Mr. Vieillefosse's declaration dated March 14, 2000 which unequivocally stated that the present place of residence of the inventor was not known to the assignee of the above application since Mr. Dubois has moved to another city and has refused to provide his present address. The only address known to the Assignee for Mr. Dubois was his place of employment. Therefore, to the best of Applicant's ability, Applicant has attempted to provide the last known address of the inventor Mr. Dubois. His present address is not known to the Applicant and the address that is known to the Applicant, namely, his place of employment has been provided to the Patent Office. Therefore, Applicant has complied with item 4 as well as item 3. Applicant cannot provide information that Applicant does not have but Applicant has provided a means to reach the inventor at his place of employment.

Therefore, the record is believed to clear as to all of the points required by Rule 1.47(b) and therefore, granting of the petition is requested.

Respectfully submitted,
Bierman, Muserlian and Lucas

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CAM:ds

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Charles A. Muserlian

Charles A. Muserlian

August 3, 2000